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IN THE

Supreme Court of the United States

Term, 19

No. ~~992~~ 132

INTERNATIONAL LATEX CORPORATION,

Petitioner,

v.

THE WARNER BROTHERS COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

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To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, International Latex Corporation, respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Second Circuit to review a judgment of that court entered March 11, 1960.

A certified transcript of record, including the proceedings in said Circuit Court of Appeals, has been filed herein pursuant to Rule 21(1) and (3).

The opinions in the courts below

Court of Appeals, Second Circuit, March 11, 1960, reported in 276 F. (2d) 557; 124 USPQ 479 (II, 102a) and United States District Court, District of Connecticut, Anderson, District Judge, January 13, 1959, reported in 169 F. S. 755 (I, 370a).

Grounds on which jurisdiction of this Court is invoked:

The suit arises under the Federal patent laws.

(i) The judgment of the Court of Appeals was entered March 11, 1960 (II, 118a).

(ii) Rehearing was denied on March 29, 1960 (II, 128a).

(iii) The jurisdiction of this court is invoked under Title 28 U. S. Code §1254(1). The jurisdiction of the courts below is based on 28 U. S. C. §1338(1) and §1292(4).

The Question Presented for Review:

Whether, in a patent for a significant invention, the doctrine of equivalents is applicable to the interpretation of a restricted claim, granted after rejection and cancellation of a broader claim, where such interpretation does not have the effect of recovering matter ceded in the Patent Office?

The facts material to the consideration of the question presented:

Petitioner, International Latex Corporation, sued The Warner Brothers Company in the United States District Court for the District of Connecticut for infringement of claims 1, 2 and 6 of Spanel patent 2,360,736 for a seamless dipped latex girdle.

The trial court held claims 1, 2 and 6,* valid but not infringed, interpreting the claim language calling for slightly roughened or matted inside surfaces of the deposited latex girdle to exclude "any kind of alien material attached to the surface of the deposited latex, such as flocking which is used by both plaintiff and defendant * * *"; and rejecting plaintiff's invocation of the doctrine of equivalents on the ground of file-wrapper estoppel, 169 F. S. 758, 762-3, 765 (I, 385a-387a, 390a).

The Second Circuit Court of Appeals affirmed, 276 F. 2d 557 (II, 102a, 111a-117a).

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* "1. An integral one-piece supporting girdle formed of deposited latex sheet material of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer, the external surfaces of said sheet material being smooth and the inside surfaces thereof being of a slightly roughened matted character for contact with the skin of the wearer.

"2. An integral one-piece supporting girdle formed of deposited latex sheet material of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer, the internal surfaces of said sheet material being of a matted character and such as to provide in contact with the skin an interconnected cellular formation.

"6. An integral one-piece supporting girdle formed of deposited latex of a strength and shape throughout to apply generally uniform constrictive force to the flesh around the lower torso of the wearer, the front and back areas being formed with 'pin-point' perforations distributed thereover, and the inside surfaces of the latex being of a slightly roughened matted character."

The Spanel invention

"The invention disclosed by the Spanel patent was an integral one-piece girdle of deposited latex 'of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer'."* "There was immediate and constantly increasing public acceptance of the Spanel girdle once it was put on the market" (I, 384a). The success of plaintiff's "Playtex" girdle was so marked that it led defendant's marketing expert in 1952 to say that it was "very rapidly becoming the outstanding basic staple in the foundation garment field" and to recommend "that every effort be made to design or create a similar garment" for defendant (I, 234a; 174-5a).

"The accused girdles are similar to plaintiff's patented product under Claims 1, 2 and 6 of the patent, except for the character and composition of the inside of the girdle * * *" (Finding 41; I, 378-9a).

The patent discloses, as a preferred form, a girdle whose inner surface is matted or slightly roughened to produce "a better feel to the skin and better moisture absorbent qualities" (Appendix, Note 2). "This roughened inner surface of the girdle may be produced," the patentee says, "by roughening the surface of the form on which the girdle is generated." Page 6, col. 1, lines 29-35 (I, 342a). This mold-roughening procedure for roughening the inner girdle surfaces was no part of the patentee's invention. It was "very old art," 169 F. S. 762 (I, 384a). There was also available in the prior art a second procedure for producing such a matted or roughened surface, called "flock-

* See Finding 18, 169 F. S. 758 (I, 375a), and the affirming discussion by the Court of Appeals, 276 F. 2d 557, 559 (II, 104a-105a) printed in Note 1 of an Appendix for convenient reference.

ing," in which through a prior art process fine particles of fabric, such as cotton, rayon, wool or other similar material, are applied to the deposited latex of the inside surface of the girdle before the latex has hardened (Appendix, Note 3).

At first plaintiff's girdles had a smooth inner surface. Later plaintiff used flocking to provide a matted or roughened inner surface, a practice which defendant followed when it subsequently adopted the integral latex girdle disclosed in the patent (I, 168-9a).

The Patent Office history of the claims

Of the claims in the patent application as filed, some were broad enough to cover the invention without limitation as to the texture of inner surfaces, *e.g.* claim 24 (Appendix, Note 4). Others were, like the patent claims 1, 2 and 6, restricted to roughened inside surfaces, *e.g.* claims 26 and 27 (Appendix, Note 5).

All the claims were initially rejected. After various changes in form rather than in substance the applicant cancelled the broader claims and the narrower claims were allowed.

Nowhere in the course of the Patent Office proceedings was any emphasis placed on the *procedure* for producing a roughened inside surface nor was the language used to describe the roughened or matted inside surface a matter of concern. There is no indication that the allowance of claims was dependent in any way on the particular language used in this regard.

Having however relinquished the broad claims to the girdle *per se* without limitation as to the character of the inside surface, the patentee and your petitioner are bound by that disclaimer.

Neither in urging an interpretation of claims 1, 2 and 6 that does not exclude flocking, nor in seeking inclusion of flocking under the doctrine of equivalents, has it been sought to recover ground ceded in the Patent Office.

The Court of Appeals said, 276 F. 2d 564 (II, 115a):

> "Plaintiff is right in asserting that when it asks us to apply the doctrine of equivalents to include flocking within claims 1, 2 and 6, it is not seeking to produce the result, * * * of recovering ground that Spanel had ceded in the patent office—as would be the case if it were contending that a smooth inner surface girdle was the equivalent of a roughened one."

Argument amplifying the reasons relied on for the allowance of the writ

The special and important reason relied on for the allowance of the writ is that the Court of Appeals has decided an important question of patent law in conflict with applicable decisions of this Court.

Its judgment brings into question basic principles of patent claim interpretation upon which the doctrine of equivalents rests and, more particularly, the application of that doctrine where the accused embodiment is outside the literal verbalism of the claims or is not an alternative expressly disclosed in the patent specification, although available in the art.

These principles are:

Point 1. That where the court has found that the alleged discovery or invention has advanced the art substantially, then the court is liberal in its construction of the patent to give to the inventor the award he deserves, *Eibel Co.* v. *Paper Co.*, 261 U. S. 45, 63, and in a case of doubt where the claim is fairly susceptible of two constructions will adopt that one which preserves to the patentee his actual invention. *Smith* v. *Snow*, 294 U. S. 1, 6.

Point 2. That even if the alleged infringement does not fall within the literal language of the claims, the doctrine of equivalents is available to embrace it in circumstances such as those presented here, lest verbalism replace the wholesome realism of the doctrine and by subordinating substance to form defeat the primary purposes of the patent system. *Graver* v. *Linde*, 339 U. S. 605, 607-8.

Point 3. That under the doctrine of file wrapper estoppel these basic rules of interpretation remain applicable to claims restricted in the Patent Office so long as inclusion of known equivalents of elements defined in those claims does not have the effect of recovering ground ceded by the applicant. *Exhibit Supply Co.* v. *Ace Corp.*, 315 U. S. 126, 134-5.

Point 4. That to establish file wrapper estoppel it must appear that the subject matter [in this case the choice of a particular type of slightly roughened or matted inner surface of the latex girdle] was embraced within the subject of discussion between the examiner and the applicant.

Exhibit Supply v. *Ace, ante; Bird* v. *Sears, Roebuck Co.*, 299 F. 574, 576 (CCA 2).*

The *ratio decidendi* of the Court of Appeals

The Court, saying 276 F. 2d 562-3 (II, 112a), "Plaintiff's interpretation of the claims to include flocking is inadmissible," emphasizes that in the claims "nothing suggests the roughened surface is to be part latex and part something else."

Turning to the specifications it correctly found in the patentee's phrase "the inside surface of the latex walls of the girdle preferably has • • • a texture • • • of a more matted character," nothing suggesting the addition of something else to the latex surface; and, as "even more significant," that the roughening procedure disclosed roughened the surface of the deposited latex without the addition of anything else, and that "nowhere, in the 114 pages of the file, would a searcher encounter a single reference to flocking."

Although this emphasis is, we submit, irrelevant to the issue, which does not depend on whether the specifications do or do not suggest "the addition of something else", there is nothing factually wrong with this recital. The patentee did not anywhere specifically disclose or suggest any other way of roughening than the mold-roughening.

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* If review in this Court is granted, it will be submitted on petitioner's behalf, and supported by citations, that the history of adjudication of the doctrine of file wrapper estoppel shows consistent recognition of this requirement by this Court and by the Courts of Appeals. See, for instance, the classic exposition and review of this familiar rule by Judge Putnam in *Reece* v. *Globe*, 61 F. 958, 968-970.

which added nothing but roughness to the deposited latex. In the 114 pages of the file there is, beyond the specification of the patent itself, no reference to flocking or to mold-roughening or to any other way of roughening the latex surface. The specifications did not go beyond the disclosure of one way in which it might be done. The roughening *procedure*, which was no part of the invention, never in any way entered into the discussions between the applicant and the Patent Office examiner.

It was against this background that the Court concluded that "plaintiff's interpretation of the claims to include flocking is inadmissible" and said:

> "Plaintiff can therefore prevail as to infringement on claims 1, 2 and 6 only if this is a proper case for applying the doctrine of equivalents." 276 F. 2d 563 (II, 113a)

Approval withheld from trial court on equivalence as a matter of fact

At this point in its opinion the Court of Appeals turned to Judge Anderson's finding that "Even if the doctrine were not ruled out as a matter of law, 'flocking' as used in the accused girdles is not in fact the equivalent of the roughened or matted internal surfaces of the girdles as described in the patent claims."

From this the Court of Appeals withheld approval. It said: "Admittedly the two processes serve the same objectives—promoting evaporation, lessening too close a sticking to the skin, and giving a softer and more comfortable feel." 276 F. 2d 563 (II, 113a); and as to Judge Anderson finding that flocking is superior to roughened or matted latex surfaces without flocks, and "more ex-

pensive than the process of roughening contemplated by the patent"* it commented, 276 F. 2d 563 (II, 113a-114a):

> "And neither the superiority of flocking nor its being more expensive, in an unstated degree, would require a determination that it passed the bounds of equivalence in a proper case. (citing cases) We should thus have difficulty in saying that under no circumstances could flocking be deemed an equivalent for abrading the inner surface of latex; however, that issue is an unreal one, arising out of the attempted dichotomy of 'equivalence' as between fact and law. The only question of interest to the parties is whether flocking is to be treated as an equivalent under the circumstances here. We think not."

Thus the Court of Appeals rested its judgment not on lack of equivalence as a matter of fact but rather on "the circumstances here"; that is to say, because the claims were "drastically narrowed" in the Patent Office.

The practical effect of the Court's judgment was to strip the patentee and your petitioner of all realistic monopoly right to the invention. This complete emasculation of a patent for a concededly significant invention used by the defendant, on the sole ground that defendant had replaced by a known substitute *procedure* the roughening procedure mentioned in the patent when the surface roughening procedure was no part of the invention, must have, we think, a shocking incidence on anyone. It seems to have left a feeling of shock with the Court of Appeals itself. Agreeing with plaintiff's counsel that the inventor Spanel was left with nothing but the glory of the invention, the Court said, 276 F. 2d 565 (II, 117a):

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* 169 F. S. 755, 763-4 (I, 387a-388a).

> "Plaintiff's disappointment is understandable. But the result stems from Spanel's decision not to appeal the examiner's rejection of the claims embodying his basic invention but rather to accept a patent with *exceedingly* narrow and restricted claims." (Emphasis supplied.)*

Application of the doctrine of equivalents refused.

The Court of Appeals then turned, in its opinion, directly to the applicability of the doctrine of equivalents under the circumstances of the case at bar, and developed the reasoning by which it reached the conclusion of non-infringement.

The Court refers to the opinion written by Judge Learned Hand in *Royal* v. *Remington*, 168 F. 2d 691, 692, as emphasizing "the necessarily imprecise nature of the doctrine" and to Judge Hand's opinion in *Deitel* v. *Unique*, 54 F. 2d 359, 360, in which application of the doctrine of equivalents was found to be inappropriate, as showing "how small the benefit appropriate in a particular case may be" and concluded (II, 114a):

> "We think a similar result ought [to] follow when, as here, although the invention may have been broader, the applicant *drastically* narrowed his claims to overcome difficulties in the Patent Office." (Emphasis supplied.)

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* We emphasize the adverb "exceedingly" and the later use of "drastically" because they expose a turn of the thinking of the Court of Appeals away from the question whether in the file wrapper there was evidence of surrender of the concrete subject matter here sought to be reached, toward a wholly subjective unmeasured judgment that the claims allowed were "exceedingly" or "drastically" narrowed. It was this wrong turn that led to the shocking practical impact of the Court's judgment.

The Court regarded Judge Hand's opinion as to claim 19 in *Intercontinental* v. *Sterilek*, 94 F. 2d 10, at 11-12, as "at least a signpost along that road"; perhaps because it cited *Deitel*.

Then, after noting that plaintiff is not seeking to recover "ground that Spanel had ceded in the Patent Office" the Court nevertheless—adopting a phrase from another opinion of Judge Learned Hand—said (R. 115a):

> "Nonetheless we think it would be incongruous to apply an equitable doctrine, which is 'in misericordiam to relieve those who have failed to express their complete meaning,' *Claude Neon Lights* v. *E. Machlett & Son*, 36 F. 2d 574, 576 (2d Cir. 1929)." *

The decision of this Court in *Graver*

Coming finally to consideration of the decision of this Court in *Graver*, the Court of Appeals finds that decision not inconsistent with its conclusion here because (1) the alternative in *Graver* had been disclosed in the specification** and (2) because the alternative was embraced in a

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* This characterization of the doctrine of equivalents as "in misericordiam" evidences again the Court's wrong turn away from the obligation to find in the Patent Office proceedings concrete evidence of consideration of the subject matter of the alleged estoppel, toward abstract judgment, unsupported by any such evidence, of the patentee's deserts at the mercy seat. We submit that the doctrine of equivalents is not a doctrine of commiseration, pity or mercy oriented toward the patentee or the patent owner, but is a doctrine whose principle and purpose is to guard against converting the "protection of the patent grant into a hollow and useless thing," primarily for the general welfare and only secondly for doing justice to the patent owner. *Graver* v. *Linde*, 339 U. S. 605, 607-8.

** But compare *Exhibit Supply Co.* v. *Ace Corp.*, 315 U. S. 126, where this Court confronted with file wrapper estoppel interpreted the restrictive words "embedded in the table" to include nails driven into the table although no such embodiment was disclosed in the patent.

broad claim granted by the Patent Office but ultimately declared invalid, 276 F. 2d 564 (II, 115a)—a fact that excluded file wrapper estoppel.

At this point, the Court makes reference to a footnote 49 in an article "The Doctrine of Equivalents Revalued," 19 Geo. Wash. L. Rev. 491, 502. That footnote reads as follows:

> "In theory, much of the dissent of Justice Black in the Graver Tank case appears well founded, but the dissent appears totally to ignore the presence of a broad claim in the patent as issued. Were it not for the broad claim, the arguments of the dissent would be difficult to overcome. But, with the broad claim present, it is difficult to find the dedication to the public upon which the dissent appears to be based."

Finally the Court of Appeals adds to its opinion the following footnote, 276 F. 2d 564 (R. 116a):

> "The same note concludes (p. 497) that where the hardship to the patentee relied on as a basis for invoking the doctrine of equivalents stems from limitation of claims as a result of prosecution before the patent office, the case 'is not such as to warrant aid from the doctrine but instead is more properly viewed as a condition resulting from the patentee's own mistakes of judgment * * * even though the extent of financial loss to the patentee may be extreme.'"

Conclusion

For the purpose of this petition we have thus reviewed the legal reasoning on which the Court of Appeals based its judgment that the claims in issue must be so limited as to exclude a roughened surface unless it is all latex and not part latex and part something else.

We have urged that the decision below puts again in doubt principles and policies of patent claim interpretation established by the decisions of this Court * and reflects a rejection of the wholesome realism expressed by Justice Jackson in *Graver* (339 U. S. 606, 607)

> "Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions which is one of the primary purposes of the patent system."

The basic error of the Court lay in its holding that the doctrine of equivalents is not available in the interpretation of narrowed claims even though such interpretation would not have the result of recovering ground ceded in the patent office but would cover merely known alternatives of the elements claimed. The practical effect in this case was to emasculate the patent for a significant invention. In general application, the decision sets a precedent having

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* The decision might even be advanced, we suppose, to support the idea that "The doctrine of equivalents had changed from a routine tool of the patent courts to an equitable last resort * * *," to use the author's words at page 504 of the George Washington Law Review article referred to by the Court of Appeals.

potentialities of great harm to the patent system, since in the great majority of cases, the claims as originally presented are narrowed to a greater or less degree in the patent office. To arbitrarily deny narrowed claims the benefit of the doctrine of equivalents is, in substantial effect, to nullify the doctrine itself with the result, of great economic significance, that most patent rights will be thrown into an area of doubt capable of converting "the protection of the patent grant into a hollow and useless thing." *Graver* v. *Linde*, 339 U. S. 605, 607.

Additionally we will urge if the writ is granted that the rigid verbalism of the court's interpretation of claims 1, 2 and 6 to exclude the addition of "something else" violates the principles announced in the *Eibel* and *Smith* case (Point 1, *ante* p. 7) and the subordinate rule of *Elizabeth* v. *Pavement*, 97 U. S. 126, that the addition of something else to the claimed subject matter, even though an improvement, does not escape infringement.

Respectfully submitted,

WILLIAM H. DAVIS
Attorney for Petitioner

New York, N. Y., June 7, 1960

APPENDIX

Note 1

"The novelty of Spanel's conception, which was the basis of the patent in suit * * * [lay] * * * in a thought that for the first time made a seamless latex garment feasible as a girdle. * * * As set forth in the patent, Spanel found that by using a liquid latex material for the walls of the girdle 'considerably thicker than has been heretofore usually employed in the manufacture of garments from liquid latex,' * * * he * * * could produce a garment which, as the District Court found, 169 F. Supp. 758, 120 USPQ at 151, 'supports and constricts the wearer's torso, giving a firm, slimmed appearance, without markedly restricting freedom of movement.' " 276 F. 2d 559, 561 (II, 104a-105a)

"We agree with the District Court that the patent is valid because of the invention in Spanel's basic concept. * * *

"Although the prior art had disclosed the advantages of using rubber in garments for constricting purposes and the feasibility of seamless latex objects in general, Spanel was the first to develop a seamless latex girdle having such features of thickness, tensile strength, shape and size that the garment would produce the desired shaping effect on the wearer's body although, or rather because, the garment was not tailored to the particular form of the body." 276 F. 2d 562 (II, 110a)

And see the trial judge's discussion at 169 F. S. 761-2 (I, 382a-384a).

Note 2

"Moreover, according to the invention, the inside surface of the latex walls of the girdle preferably has a less smooth texture than the outside, which texture, being of a more 'matted' character, tends to produce a better feel to the skin and better moisture absorbent qualities.

"It is desired to produce a very decided difference of texture between the inside surface of the girdle and the outer surface thereof, and the invention also contemplates a girdle made from liquid latex having a smooth outer surface and a roughened inner surface next to the skin." Page 6, column 1, lines 18-35 (I, 342a)

Note 3

Finding 43. "The accused girdles differ from the plaintiff's patented girdle as described in Claim 1, 2 and 6, in that they are 'flock lined,' i.e. through a prior art process, fine particles of fabric such as cotton, rayon, wool or other similar material are applied to the latex of the inside surface of the girdle." 169 F. S. 760 (I, 379a)

"defendant's girdles accomplished the departure from smoothness in the interior surface, desired to promote evaporation and provide a more comfortable 'feel,' not by abrading the surface of the latex, as Spanel had taught, but by a process, known as 'flocking,' which applies fine particles of fabric such as cotton, rayon or wool before the latex has hardened. Plaintiff likewise has used 'flocking' on all its girdles which do not have smooth inner surfaces": 276 F. 2d 561 (II, 109a)

Note 4

Original claim 24. "As an article of manufacture, a hollow, deposited, latex, supporting girdle, adapted when placed in position on the lower portion of the human torso to stretch thereon to form a continuous, stretched, skin-like, relatively smooth surface, while supporting the body of the wearer." (File History, Def. Exh. L, p. 24)

Note 5

Original claim 26. "As an article of manufacture a hollow, latex, supporting girdle provided with walls adapted to enclose a portion of the body of the wearer, the outsides of said walls presenting smooth surfaces, while the insides of said walls which are adapted to be contiguous to the skin of the wearer, present roughened surfaces.

Original claim 27. "As an article of manufacture a hollow, latex, supporting girdle provided with walls perforated by a plurality of small openings extending from the outside of said walls to the interior thereof, the outside of said walls presenting smooth surfaces while the inside of said walls present rough surfaces." (File History, Def. Exh. L, p. 25)